

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): Riedl et al.
Docket No.: TWC-IPV-03-13/1033-14
Serial No.: 10/626,114
Filing Date: July 24, 2003
Group: 2423
Examiner: Jasmine N. Stokely-Collins

Title: Technique for Communicating Relatively High And Low Priority Data Between a Terminal and a Remote Location

APPLICATION FOR PATENT TERM ADJUSTMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following application is submitted in response to the Determination of Patent Term Adjustment dated August 6, 2009 in the above-identified application.

APPLICATION FOR PATENT TERM ADJUSTMENT

Applicants have reviewed the Determination of Patent Term Adjustment dated August 6, 2009.

With regard to 37 CFR 1.705(b)(1), applicants are paying the fee under 37 CFR 1.18(e) herewith. In the event that the accompanying fee is incorrect, the Commissioner is authorized to charge or to credit **Ryan, Mason & Lewis Deposit Account No. 50-0762** as required to correct the error.

With regard to 37 CFR 1.705(b)(2)(i) and (ii), according to the pertinent rules there are three different bases under which delays can occur. These are (1) failure to act; (2) extensions for interferences, successful appeals, and secrecy orders; and (3) three year pendency term.

The first basis is failure to act by the USPTO, also known as the 14-4-4-4 rule (see 37 CFR 1.702(a) and 37 CFR 1.703(a)). Under this rule, the USPTO is required to mail an action not later than 14 months after the filing date of the application. In this case, the application was filed on 7/24/03 and the first office action was mailed on 10/03/07, i.e. **1104** days after the 14-month due date (9/24/04).

Furthermore, the USPTO failed to act within 4 months after an appeal brief was filed (see 37 CFR 1.702(a)(2) and 37 CFR 1.703(a)(4)). The appeal brief was filed on 3/6/09 and the Notice of Allowance was mailed on 8/6/09, which is **31** days after the 4 months date (7/6/09). Therefore, the total delay under the failure to act rule is $1104+31=1135$ days.

In addition, as noted above, the third basis for USPTO delays is the requirement for a three year pendency from filing of an application until the date it issues as a patent. (See 37 CFR 1.702(b) and 37 CFR 1.703(b)). The period of adjustment under this time frame is the number of days in the period beginning on the day after the date that is three years after the actual filing date of the application and ending on the date a patent was issued. However, there are several prosecution activities that are excluded from the calculation of the adjustment period, including period consumed by continued examination of the application (the number of days in the period beginning on the date on which a request for continued examination (RCE) was filed and ending on the date the patent was issued), see 37 CFR 1.703(b)(1). In this case, an RCE was filed on 7/15/08. Therefore, since the continued examination period is excluded from the calculation, the

period of adjustment under three year pendency term is the number of days in the period 7/25/06-7/15/08, which is equal to **722** days.

According to the rules, the total adjustment period based on USPTO delays is the sum of all of the delays described above, minus any overlap between the adjustment periods. The USPTO has declared that the three year pendency delay starts from the day the application is filed and includes the entire prosecution period, but only if there is also 14-4-4-4 delay. Therefore, the 14-4-4-4 delay and three year pendency delay necessarily overlap and an applicant cannot get credit for both delays. In this case, the USPTO gave applicant the longer of the two delays – **1135 days**.

However, *Wyeth v. Dudas*, 88 USPQ2d 1538 (D.D.C. September 30, 2008) held that the USPTO had misconstrued the law by including the entire prosecution period as part of the three year pendency delay and was improperly calculating the adjustment period. **The court found that applicants are entitled to the sum of the 14-4-4-4 delay (1135 days in this case) and the three year pendency delay (722 days in this case), minus any overlap, not just the longer of two delays.** In this case there is an overlap between the reduction periods (7/25/06-10/03/07), which is equal to **436** days.

Therefore, applicants respectfully assert that they should be entitled to **1421 days (1135+722-436)**. Applicants accordingly respectfully request that the patent term calculated by the USPTO be adjusted by lengthening same by **286** days.

With regard to 37 CFR 1.705(b)(2)(iii), there is no terminal disclaimer in this case.

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With regard to 37 CFR 1.705(b)(2)(iv), it is respectfully noted that the sole issue believed to be present in this case is the issue of the USPTO interpretation of the statute and rules as opposed to that set forth by the *Wyeth* court, inasmuch as the patent term adjustment calculated by the USPTO appears to be correct based upon the USPTO's interpretation, but not the holding of the *Wyeth* case; to the best information and belief of the undersigned, there are no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination which would require any modification of the calculated patent term adjustment as set forth above.

Respectfully submitted,



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Date: October 28, 2009